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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,217	09/25/2001	Kaoru Indoh	214129US0XPC	8456

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER

HENDRICKS, KEITH D

ART UNIT	PAPER NUMBER
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1761

DATE MAILED: 03/26/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/926,217

Applicant(s)

INDOH ET AL.

Examiner

Keith Hendricks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 05, 2003 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1, and thus claims 3-5 and 6-7, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants' specification and original claims describe a range of water "employed in a volume amount 1.35 – 1.65 times the weight of the raw material mixture" Applicants have amended the claims to recite a water "volume amount 1.35 – 1.50 times." Initially, it is not clear as to where applicants derive the specific endpoint of a water volume 1.50 times the weight of the raw material. Applicants refer to example one, however, it is not clear from this passage in the specification. Secondly, this range is not supported by the original specification, such that the amounts above 1.50 up to and including 1.65%, are excluded. The specification provides examples of 1.35 and 1.65 as specific individual points; however, it does not provide support for a subset "volume amount 1.35 – 1.50 times", from the originally-disclosed range of "1.35 – 1.65 times." Equally, nor would it provide support for the intrinsic excluded subset of "above 1.50 up to and including 1.65", and although this subset is not claimed or set forth by applicant, neither new range would be supported by the original disclosure.

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The burden now shifts to applicant to demonstrate possession of the later-claimed range, at the time the invention was made. The range not having been specifically named or mentioned in any manner, one is left to the selection from the myriads of possibilities encompassed by the broad disclosure, with no guide indicating or directing that this particular selection should be made, rather than any of the many others which could also be made. Where a later claimed invention is not specifically named or mentioned in the specification as filed, the fact that there may even be some motivation for a person of skill to want to make it, and that such person would be enabled by the specification to make it, *is not relevant* to the point as to whether the original specification conveys to those skilled in the art, in any way, the information that applicant had invented this later-claimed invention. See *In re Wertheim*, 191 USPQ 90 (CCPA 1976).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

i) Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata et al. (US PAT 5,665,407, of record).

Nagata et al. discloses a process for the production of a “light-colored seasoning liquid”, comprising the first step of forming a “koji-making material” of

(a) 70-90% wheat and/or gluten, wherein the gluten is present in amounts of 25-100% by weight of the total of component (a), and wheat is present in amounts of 0-75% by weight of the total of component (a), and

(b) 10-30% soybean.

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To the material is added a koji starter seed, and salt water to give a moisture content of 35-50% (mid-col. 2). The resultant mixture is fermented for "at 10°-60°C for 3 days to 5 months" (top-col. 3).

Thus, the claims are anticipated by the reference.

Applicants' arguments filed March 05, 2003, have been fully considered but they are not persuasive. In view of the obviousness rejection previously necessitated by applicants' improper amendment to the claims, applicants state that example 1 demonstrates "result-effectiveness due to this claim limitation" of "1.35 to 1.50 times" water volume, which is neither disclosed nor obvious.

This is not deemed persuasive for the reasons of record. Secondary considerations of obvious are not germane to a rejection under 35 U.S.C. 102(b) where the reference anticipates and teaches the limitations of the claims. Again, these ranges and amounts of water content and salt content appear to fall within applicants' claims of 1.35-1.50 (1.35-1.65) times the weight of the raw material mixture. Note that the claims do not require the presence of two of the three raw materials (soy and wheat at a possible 0%), thus affecting the percentage amount of water utilized therein, as well.

**ii)** Claims 1 and 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tobe et al. (US PAT 6,054,150).

Tobe et al. disclose a method of producing seasoning liquids, by adding a soy sauce seed koji to a wheat gluten material. The ranges and amounts of water content and salt content appear to fall within applicants' claims of 1.35-1.50 (1.35-1.65) times the weight of the raw material mixture; see especially column 3, lines 30-35, where it is stated that 1-30% v/v of salt brine, preferably 10-28%, is used.

Note that applicants' claims read upon the use of 0% soybean and 0% wheat, thus reading upon the koji fermentation of gluten in a 7-24% salt water material in a volume of 1.35-1.50 times the weight of the gluten (claim 1). Note that applicants claims do not exclude the presence of soy material in the fermentation mixture, but rather only in the raw material itself. Any soy material contained in the koji seed of the reference is thus not excluded by the instant claims.

**iii)** Claims 1 and 3-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima et al. (US PAT 5,869,115).

Fukushima et al. disclose a process for producing a seasoning from proteinaceous materials selected from soybean, wheat, wheat gluten and corn gluten. Koji mold is added to the material, as well

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as water and common salt up to 15%. The ranges and amounts of water content and salt content appear to fall within applicants' claims of 1.35-1.50 (1.35-1.65) times the weight of the raw material mixture; see Example 1, and column 2 of Fukushima et al., where it is stated that "not more than 15% of common salt" is used.

Note that applicants' claims read upon the use of 0% soybean and 0% wheat, thus reading upon the koji fermentation of gluten in a 7-24% salt water material in a volume of 1.35-1.50 times the weight of the gluten (claim 1).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (703) 308-2959. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (703) 308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9565 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



**KEITH HENDRICKS  
PRIMARY EXAMINER**